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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/737,413	12/14/2000	Santokh S. Badesha	D/A0592Q	8801
7:	590 11/21/2002			
John E. Beck			EXAMINER	
Xerox Corporation Xerox Square 20A			FERGUSON, LAWRENCE D	
Rochester, NY 14644			ART UNIT	PAPER NUMBER
			1774	4
			DATE MAILED: 11/21/2002	,

Please find below and/or attached an Office communication concerning this application or proceeding.

		The second			
	Application N .	Applicant(s)			
Office Action Summany	09/737,413	BADESHA ET AL.			
Office Action Summary	Examiner	Art Unit			
The MAII INC DATE of this communication ann	Lawrence D Ferguson	1774			
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply					
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). Status					
1)⊠ Responsive to communication(s) filed on <u>13 S</u>	eptember 2002 .				
	s action is non-final.				
3)☐ Since this application is in condition for allowa		rosecution as to the merits is			
closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213. Disposition of Claims					
4)⊠ Claim(s) <u>1-21</u> is/are pending in the application.					
4a) Of the above claim(s) is/are withdrawn from consideration.					
5) Claim(s) is/are allowed.					
6)⊠ Claim(s) <u>1-10,13-17 and 20</u> is/are rejected.					
7) Claim(s) <u>11,12,18,19 and 21</u> is/are objected to.					
8) Claim(s) are subject to restriction and/or election requirement.					
Application Papers ○ □ The specification is objected to by the Examiner					
9) The specification is objected to by the Examiner.					
10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.					
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). 11) The proposed drawing correction filed on is: a) approved b) disapproved by the Examiner.					
If approved, corrected drawings are required in reply to this Office action.					
12) The oath or declaration is objected to by the Examiner.					
Priority under 35 U.S.C. §§ 119 and 120					
13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).					
a) All b) Some * c) None of:					
1. Certified copies of the priority documents have been received.					
2. Certified copies of the priority documents have been received in Application No					
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received. 					
14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).					
a) ☐ The translation of the foreign language provisional application has been received. 15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.					
Attachment(s)					
1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s)	5) Notice of Informal F	r (PTO-413) Paper No(s) Patent Application (PTO-152)			
I.S. Patent and Trademark Office					

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DETAILED ACTION

Response to Election

1. This action is in response to the provisional election, mailed September 13, 2002. Claims 1-19 and 21 were provisionally elected rendering Claim 20 held to a non-elected invention. Examiner withdraws the restriction requirement rendering Claims 1-21 pending.

Claim Rejections – 35 USC § 102(b)

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- 3. Claims 1-10, 13-17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Badesha et al (U.S. 5,846,643).
- 4. Badesha teaches the conventionality of an image forming electrostatographic apparatus for forming images on a support comprising a development component, a transfer component and a fixing component (column 1,lines 16-48) having an intermediate component (column 3, lines 44-45). Badesha discloses an electrostatographic printing apparatus comprising a silicone elastomer and a mica type layered silicate, said silicone elastomer and mica-type layered silicate forming a delaminated nanocomposite (column 4, lines 1-5) where the silicone elastomer is a

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polyorganosiloxane wherein the polyorganosiloxane has the same formula displayed in claim 7, where R is hydrogen or substituted or unsubstituted alkyl, alkenyl or aryl having less than 19 carbon atoms, each of A and B may be any of methyl, hydroxy or vinyl groups and 0<m/n<1 and m+n > 350 (column 4, lines 10-24). Additionally, the reference has the same formula limitation presented in claim 2, where W is usually potassium; X, Y are aluminum, magnesium, iron or lithium and Z is silicon or aluminum (column 5, lines 40-46). Badesha discloses the formula in claim 9 where n" is 350 to 2700 (column 7, lines 1-10). Badesha discloses 10% weight of the mica-type silicate (column 5, lines 9-10) where the mica-type silicate comprises hectorite (column 14, lines 9-10). An image for forming images on a recording medium is directed to intended use. A transfer component for transferring said developed image from said chargeretentive surface to an intermediate transfer component and an intermediate transfer component for receiving said developed image from said transfer component are also directed to intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 458, 459 (CCPA 1963). A development component to apply a developer material to said charge-retentive surface to develop said electrostatic latent image to form a developed image on said charge-retentive surface is a product by process claim

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limitation. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966.

5. Claims 11-12, 18-19 and 21 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for

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After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.

Lawrence D. Ferguson Examiner Art Unit 1774 CYCHTHIA H. KELLY SYCHOLOGY PATENT EXAMINER TELLINGLOGY CENTER 1700

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